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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,962	09/10/1999	LESTER D. NELSON	103589	3538

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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/393,962

Applicant(s)

NELSON ET AL.

Examiner

Ahshik Kim

Art Unit

2876

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/30/03 (CPA).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Prosecution Application

1. The request filed on May 30, 2003 for a Continued Prosecution Application (CPA) under
5 37 CFR 1.53(d) based on parent Application No. 09/393,962 is acceptable and a CPA has been
established. An action on the CPA follows.

Amendment

2. Pursuant to filing of CPA as mentioned in paragraph 1, the amendment filed on April 29,
10 2003 is now entered (Paper #17). In the amendment, claims 1, 9, 16, 21, and 22 were amended.
Claims 1-16 and 18-22 remain for examination.

Drawings

3. Some of the drawings (figures 33 and 34) appear somewhat informal compared to the rest
15 of the drawings. Applicant is respectfully solicited to submit formal drawings in response to this
Office Action.

Obviousness-Type Double Patenting

4. Claims 1-16 and 18-22 are rejected under the judicially created doctrine of
20 obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No.
6,195,093 to Nelson et al. (hereinafter '093 patent).

Art Unit: 2876

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1, 9, 16, 21, and 22 of the instant application, Applicants claim a system and the methods for controlling a presentation comprising at least one presentation element, and a sensor that senses at least one presentation element and at least one control
5 element identifier controlling the presentation element.

Claim 1 of '093 patent similarly recites "A system for controlling a presentation using a tangible, sensible identification-carrying device comprising at least one presentation element identifier that identifies at least one of at least one presentation element and a presentation control function, the system comprising: a sensor; a controller; and a display that
10 displays".

Claims 1 and 9 of the instant application are not word by word identical to claims 1 and 9 of '093 patent, however, the instant application and '093 patent disclose the apparatus and the methods that are essentially the same. However, the scope of the claim 1 of '093 patent seems to be narrower than subject matter recited in claim 1 of instant application since '093 patent recites
15 "..... at least one presentation element and a presentation control function" whereas claim 1 of instant application only recites "presentation element" (although "control element" appears in subsequent dependent claims).

Claims 2 and 3 of the instant application and the corresponding claims of '093 patent essentially disclose same memory device which stores presentation element, presentation
20 element identifier and a controller associating a presentation element with a presentation element identifier. Although instant application differs from '093 patent in that in instant application, a "presentation control element" is treated as an independent variable controlling the presentation,

Art Unit: 2876

whereas identifier '093 patent is associated with both "presentation element" and "presentation control function", it is the Examiner's view that such modification would have been obvious to one ordinary skill in the art to provide the apparatus improved versatility.

In claims 6 and 7 of instant application and '093 patent, candidate materials for the
5 identification device and display are disclosed which are virtually identical.

Therefore, in view of above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 1-20 of '093 patent as a general teaching to design a system for controlling presentation with added (or slightly different) functionality. The instant claims obviously encompass the patented claims and
10 differ only in terminology. To the extent that the instant claim is broader and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base
15 upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CRR § 1.321 (b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37
20 CRR § 1.78(d).

Art Unit: 2876

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the
10 claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
15 and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichek et al. (US 5,960,448) in view of Wittensoldner et al. (US 5,144,114).

Reichek teaches a system for controlling a presentation, wherein a bar code scanner senses a bar-coded presentation element identifier 1410 on a document (see col. 3, lines 55+ and
20 figure 14). Controller 260 recognizes the scan and uses presentation database memory 240 to select the respective presentation element stored therein. Once selected, the presentation element is displayed on display device 121, which could be a screen projector, a flat panel display, or an overhead projector (col. 4, lines 26-31). The bar-coded document, generated by the system, may simply be a hard copy sheet of paper.

25 Reichek, however, fails to teach the presence of a control element identifier that associates a control element, the control element to be sensed by the controller and affects the

Art Unit: 2876

presentation element in a predefined manner other than by visual modification of the presentation element.

Wittensoldner teaches a scanner system, in which the scanning of a bar code on a label increases or decreases the volume of an audible speaker used with the system. It would have been obvious to one of ordinary skill in the art at the time of invention was made to employ such a barcode to affect the presentation in a similar manner. Within the realm of scanning the bar code to show documents and other elements stored (as in Reichel), having a barcode to change the start the presentation, stop it, rewind it a frame, or change the volume of the presentation would be fall accordingly. Having this feature continues the automated operation of the presentation and provides convenience as it alleviates the need for handling extraneous devices to control the presentation, such as an attached, but separate speaker/amplifier device or playback device (similar to a VCR). The presenter would merely start or stop the presentation or change the volume by merely swiping a bar code, providing an easy and timing saving step.

15

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Furusawa (US 5,805,152); Lyons et al. (US 6,283,860); Chernock et al. (US 6,314,569); disclose a system and the methods for controlling presentation.

20 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

25 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Art Unit: 2876

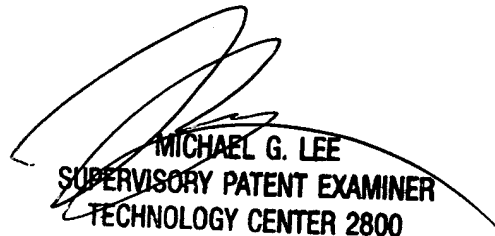
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
August 21, 2003



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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